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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,271	10/31/2003	Dennis M. Newns	YOR920030500US1	9194

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EXAMINER
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HARRIS, GARY D

ART UNIT	PAPER NUMBER
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1773

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/697,271

Applicant(s)

NEWNS, DENNIS M.

Examiner

Gary D. Harris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9&16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of 1-9 & 16-20 in the reply filed on 12/14/06 is acknowledged. The traversal is on the ground(s) that claim language would appear to be identical to the language of claim 1.

This is not found persuasive because claim 10 does not require charge migration rate of ferroelectric layer.

The requirement is still deemed proper and is therefore made FINAL.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 & 16-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,515,957.

Although the conflicting claims are not identical, they are not patentably distinct from each other because applicant describes similar features in the new application including a storage medium, ferroelectrics utilizing SrRuO<sub>3</sub>, PZT, perovskite, etc.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-4, 7, 8, 16, 17, 20 are rejected under 35 U.S.C. 102(a) as being anticipated by Higuchi et al. US 2005/0122005.

As to Claim 1, 2, & 3, Higuchi et al. '005 describes a storage medium with a bottom electrode (applicant's metallic underlayer) formed on a substrate which may be formed with metals (Paragraph 89), a ferroelectric film (applicant's data layer) formed on

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top of this bottom electrode, and a top electrode (applicants layer with charge migration) formed on top of this ferroelectric film (Paragraph 21 and Figure 1).

As to Claim 4, Higuchi et al. '005 describes ferroelectric materials which utilize perovskite structures including metal oxides which would encompass applicants claim (Paragraph 113,115-118)

As to Claim 7, Higuchi et al. '005 describe the bottom electrode which include SrRuO<sub>3</sub> and would encompass applicants claim (Paragraph 107).

As to Claim 8, Higuchi et al. '005 lists examples of ferroelectric materials which have favorable characteristics and would meets the limitations of the instant claim.

As to Claim 16, Higuchi et al. '005 teaches a ferroelectric film over underlayer and a conducting layer over ferroelectric layer (Figure 1).

As to Claim 17, Higuchi et al. '005 teaches the use of Pt, Ir, Ag, Ru or alloys can be used as constituent materials for the top electrode and would encompass applicants claim (Paragraph 117).

As to Claim 20, Higuchi et al. '005 discusses examples of metal oxides that have the perovskite structure including SrRuO<sub>3</sub> (Paragraph 107).

***Claim Rejections - 35 USC § 102 / 35 USC § 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Higuchi et al. US 2005/0122005.

As to Claim 5, Higuchi et al. '005 is silent as to specific charge migration times. However, these properties are inherent because the applicants and the inventors teach virtually identical structures with similar materials. The physical properties of similar materials will inherently be similar. The burden of proof is shifted to the applicant to

show the prior art properties are different from those claimed. See *In re Fitzgerald*, 619 F. 2d 67, 205 USPQ 594 (CCPA 1980).

In the alternative, the charge migration property would be obvious to one skilled in the art.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6,9,18,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higuchi et al. US 2005/0122005.

As to Claim 6, Higuchi et al. '005 teaches that no limitations exist on thickness (Paragraph 118) and reducing thicknesses to 5 to 25 Angstroms would be obvious to one skilled in the art to optimize ferroelectric properties, reduce cycle time and material cost.

As to Claim 9, Higuchi et al. '005 teaches that no limitations exist on thickness (Paragraph 290) and reducing thicknesses to 15 Angstroms would be obvious to one skilled in the art to optimize ferroelectric properties, and reduce cycle time and material cost.

As to Claim 18 & 19, Higuchi et al. '005 teach that there are no restrictions to top electrode thickness. However, reducing thickness to 5 to 25 Angstroms would be obvious to one skilled in the art to optimize ferroelectric properties, reduce cycle time and material cost.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary D. Harris whose telephone number is 571-272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GH



**CAROL CHANEY**  
**SUPERVISORY PATENT EXAMINER**